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09/973,762

10/11/2001

Toshiya Shimura

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EXAMINER

TAYLOR, BARRY W

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TOSHIYA SHIMURA and MINORU SUDO

Appeal 2007-3036
Application 09/973,762
Technology Center 2600

Decided: April 23, 2008

Before ANITA PELLMAN GROSS, MAHSHID D. SAADAT, and MARC S. HOFF, *Administrative Patent Judges*.

HOFF, *Administrative Patent Judge*.

ORDER REMANDING TO THE EXAMINER

This is a remand of the appeal under 35 U.S.C. § 134 from the rejection of claims 1-8, 11, 12, 14, and 17-20, in accordance with 37 C.F.R. § 41.50(a)(1). After considering the record before us, we are convinced that the instant appeal is not ready for meaningful review. Accordingly, we hereby remand the application to the Examiner to consider the following issues, and to take appropriate action.

*Clarification of rejection of claims 1-8, 11, 12, 14, and 17-20 under
35 U.S.C. § 103(a)*

Claims 1-8, 11, 12, 14, and 17-20 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Koeman in view of Valenti. The Examiner relies upon Valenti to teach certain claim limitations admittedly absent from Koeman, such as “measure[ing] a cross-talk noise characteristic of said subscriber telephone line only within an xDSL transmission frequency band” (claim 1).

Appellants filed the instant application on October 11, 2001, and have perfected a claim for foreign priority under 35 U.S.C. § 119 with regard to a Japanese application filed October 11, 2000.

Because U.S. Patent Application 2002/0041565 [hereafter, Valenti ‘565] was published on April 11, 2002, we must look to the filing dates of the two provisional applications from which Valenti claims priority. Provisional Application No. 60/222,734 [hereafter, Valenti ‘734] was filed on August 3, 2000. Provisional Application No. 60/262,548 [hereafter, Valenti ‘548] was filed on January 17, 2001. As a result, material in Valenti ‘565 must also be present in Valenti ‘734 in order to qualify as prior art to Appellants’ invention.

The Examiner refers to “Valenti” as teaching certain claim elements (Ans. 5-7), but fails to make clear that the material relied upon is present in Valenti ‘734. We note that at pages 8-10 of the Answer, the Examiner does undertake a discussion of whether *some* of the limitations at issue are met in Valenti ‘734, but this discussion does not encompass all of the elements from Valenti ‘565 relied upon by the Examiner.

The Examiner is hereby ordered to state, with respect to each and every claim element the Examiner asserts to be taught in Valenti '565, whether and where support for that teaching may be found in Valenti '734.

CONCLUSION

This remand to the Examiner pursuant to 37 C.F.R. § 41.50(a)(1) is made for further consideration of a rejection. Accordingly, 37 C.F.R. § 41.50(a)(2) applies if a Supplemental Examiner's Answer is written in response to this remand by the Board.

REMANDED

tdl/gw

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